

REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 12-21 have been added. Support for these claims may be found throughout the specification, for example at page 7, lines 27-32. No new matter has been added. Claims 12-21 are based upon claims 2-10. Upon entry of the above amendments, claims 11-21, as amended, will be pending.

Claims 1-9, and 11 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,994,493 to Krebs ("Krebs") in view of U.S. Patent RE33,748 to Meyborg *et al.* ("Meyborg") and U.S. Patent 4,443,563 to Dirlikov ("Dirlikov").

With respect to the § 112 rejections, the amendments to the claim are believed to place the claims in compliance with 35 U.S.C. § 112. Specifically, with respect to new claim 15 (based on claim 5) which is dependent on claim 11, this claim indicates that the polyester is formed from dimer fatty acid, adipic acid and 1, 6 hexylene glycol which further specifies the polyester of claim 11. For claims 16 and 17, support (and therefore basis) for these claims may be found at page 7, lines 27-32.

With respect to the rejections under 35 U.S.C. § 103(a), the Examiner notes Krebs fails to teach or suggest the use of a 1,4:3,6 dianhydrohexitol chain extender in preparing hot melt adhesives. Similarly, Meyborg fails to teach or suggest formation of hot melt adhesives using this chain extender. Furthermore, as with Meyborg and Krebs, Dirlikov fails to teach or suggest the use of a chain extender in the formation of a hot melt adhesive.

In addition, the Examiner has failed to provide a proper motivation to combine the references. None of the references teach or suggest that 1,4:3,6 dianhydrohexitol would be an effective chain extender for preparing hot melt adhesives. Furthermore, none of the "improved properties" asserted as motivation for incorporating 1,4:3,6 dianhydrohexitol as a chain extender for a hot melt adhesive relate to forming a hot melt adhesive or to providing adhesion.

The Examiner appears to be using hindsight to construct the Applicants' invention from prior art with no motivation provided for combining the references.

The Federal Circuit has made it clear that obviousness cannot be established simply by stitching together pieces of prior art using the invention as a template. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985); see also *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873 (Fed. Cir. 1985) (denouncing courts' tendency to depart from proper standard of nonobviousness "to the tempting but forbidden zone of hindsight"); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"). As a result, the Examiner has failed to provide a proper *prima facie* case of obviousness.

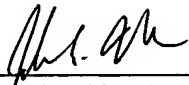
For at least these reasons, Applicants respectfully request reconsideration and withdrawal of these rejections.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

MAYER BROWN ROWE & MAW LLP

By: 

John E. Mauk
Registration No. 54,579
Direct No. (202) 263-3255

Paul L. Sharer
Registration No. 36,004
Direct No. (202) 263-3340

Intellectual Property Group
1909 K Street, N.W.
Washington, D.C. 20006-1101
(202) 263-3000 Telephone
(202) 263-3300 Facsimile

Date: September 27, 2005